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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,738	12/21/2001	Jeffrey B. Norton	16159.039001; P7221	3707
32615	7590	05/31/2005	EXAMINER	
OSHA LIANG L.L.P./SUN 1221 MCKINNEY, SUITE 2800 HOUSTON, TX 77010			NAHAR, QAMRUN	
			ART UNIT	PAPER NUMBER
			2191	
DATE MAILED: 05/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,738

Applicant(s)

NORTON ET AL.

Examiner

Qamrun Nahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is in response to the request for reconsideration filed on 12/21/2004.
2. The objection to the specification is withdrawn in view of applicant's remarks/arguments.
3. Claims 1-28 are pending.
4. Claims 1-7, 11 and 16-28 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by Song (U.S. 5,949,999).
5. Claims 8-10 and 12-15 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Song (U.S. 5,949,999) in view of Lipkin (U.S. 6,721,747).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 11 and 16-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Song (U.S. 5,949,999).

Per Claim 1:

The Song patent discloses:

- **a method for generating a software development tool** ("The present invention is a mechanism that integrates software engineering and system components to guide the

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browsing/tracking of software development documents (e.g., requirement, design, testing, etc.) and their relationships.” in column 1, lines 38-42)

- **creating a definition file defining an action to be performed by the software development tool** (“The system contains a procedure definition which defines the software development procedure.” in column 1, lines 47-48)

- **creating a schema defining characteristics of a plurality of desired inputs for the software development tool** (“An interface allows users to select phase, activity, and system components and execute other utility programs or choose options.” in column 1, lines 48-50; the interface allows the users to create a schema defining characteristics of a plurality of desired inputs for the software development tool)

- **creating a resource file comprising information required by the software development tool at runtime; and generating the software development tool using the definition file, the schema, and the resource file** (“A browser interpreter interprets the selection and decides how to form and execute each command. ... A project file contains the information about system components, physical locations of the system documents, documentation tools associated with documents, options selected, hyper-links to the documents, etc” in column 1, lines 50-52 and lines 55-59; the project file is interpreted as the resource file).

Per Claim 2:

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The Song patent discloses:

- **further comprising: creating a command list comprising a set of commands that are used to define the action** (column 1, lines 52-55).

Per Claim 3:

The Song patent discloses:

- **further comprising: generating an annotation defining custom characteristics of a user interface of the software development tool using the schema** (column 4, lines 5-13 and lines 28-35).

Per Claim 4:

The Song patent discloses:

- **further comprising: creating an annotation defining semantics of a graphical user interface of the software development tool, wherein the annotation is used with the definition file, the schema, and the resource file to generate the software development tool** (column 4, lines 5-13 and lines 28-35).

Per Claim 5:

The Song patent discloses:

- wherein the definition file further comprises references to the schema and the resource file (column 5, lines 1-42).

Per Claim 6:

The Song patent discloses:

- wherein the definition file further comprises references to the schema, the resource file, and the command list (column 5, lines 1-42).

Per Claim 7:

The Song patent discloses:

- wherein the definition file further comprises references to the schema, the resource file, and the annotation (column 5, lines 1-42).

Per Claim 11:

The Song patent discloses:

- wherein the command list comprises a transform command (column 1, lines 52-55).

Per Claim 16:

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The Song patent discloses:

- **wherein the action comprises commands** (column 1, lines 52-55).

Per Claim 17:

The Song patent discloses:

- **wherein the software development tool is generated using a software development tool generator** (column 5, lines 1-42).

Per Claim 18:

The Song patent discloses:

- **wherein the software development tool generator is integrated within an Integrated Development Environment** (column 5, lines 1-42).

Per Claim 19:

The Song patent discloses:

- **wherein the software development tool is integrated within an Integrated Development Environment** (column 5, lines 1-42).

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Per Claim 20:

This is another version of the claimed method discussed above (claims 1, 2 and 3), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

Per Claim 21:

This is another version of the claimed method discussed above (claims 1, 2 and 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

Per Claims 22 and 24:

These are computer-readable medium versions of the claimed method discussed above (claims 1 and 4, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Song.

Per Claim 23:

This is a computer-readable medium version of the claimed method discussed above (claims 2 and 3), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

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Per Claim 25:

This is a computer system version of the claimed method discussed above (claims 1, 2 and 3), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

Per Claim 26:

This is a computer system version of the claimed method discussed above (claims 1, 2 and 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

Per Claim 27:

This is an apparatus version of the claimed method discussed above (claims 1, 2 and 3), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

Per Claim 28:

This is an apparatus version of the claimed method discussed above (claims 1, 2 and 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Song.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Song (U.S. 5,949,999) in view of Lipkin (U.S. 6,721,747).

Per Claim 8:

The rejection of claim 1 is incorporated, and further, Song does not explicitly teach wherein the definition file comprises an Extensible Mark-up Language document. Lipkin teaches wherein the definition file comprises an Extensible Mark-up Language document (column 49, lines 60-67).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Song to include wherein the definition file comprises an Extensible Mark-up Language document using the teaching of Lipkin. The modification would be obvious because one of ordinary skill in the art would be motivated to provide users more flexibility with the customization of a document.

Per Claim 9:

The rejection of claim 1 is incorporated, and further, Song does not explicitly teach wherein the schema comprises an Extensible Mark-up Language document. Lipkin teaches

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wherein the schema comprises an Extensible Mark-up Language document (column 49, lines 50-54).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Song to include wherein the schema comprises an Extensible Mark-up Language document using the teaching of Lipkin. The modification would be obvious because one of ordinary skill in the art would be motivated to provide users more flexibility in customization.

Per Claim 10:

The rejection of claim 1 is incorporated, and further, Song does not explicitly teach wherein the resource file comprises an Extensible Stylesheet Language document. Lipkin teaches wherein the resource file comprises an Extensible Stylesheet Language document (column 50, lines 4-7).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Song to include wherein the resource file comprises an Extensible Stylesheet Language document using the teaching of Lipkin. The modification would be obvious because one of ordinary skill in the art would be motivated to provide users more flexibility with the customization of a document.

Per Claim 12:

The rejection of claim 11 is incorporated, and further, Song does not explicitly teach wherein the transform command initiates an Extensible Stylesheet Language processor. Lipkin

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teaches wherein the transform command initiates an Extensible Stylesheet Language processor (column 51, lines 52-58 and column 52, lines 25-33).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Song to include wherein the transform command initiates an Extensible Stylesheet Language processor using the teaching of Lipkin. The modification would be obvious because one of ordinary skill in the art would be motivated to provide users more flexibility with the customization of a document.

Per Claim 13:

The rejection of claim 1 is incorporated, and further, Song does not explicitly teach wherein the annotation comprises an Extensible Mark-up Language document. Lipkin teaches wherein the annotation comprises an Extensible Mark-up Language document (column 52, lines 7-19).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Song to include wherein the annotation comprises an Extensible Mark-up Language document using the teaching of Lipkin. The modification would be obvious because one of ordinary skill in the art would be motivated to provide users more flexibility with the customization of a document.

Per Claim 14:

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The rejection of claim 3 is incorporated, and further, Song does not explicitly teach wherein data obtained by the user interface is stored as metadata. Lipkin teaches wherein data obtained by the user interface is stored as metadata (column 2, lines 34-40).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Song to include wherein data obtained by the user interface is stored as metadata using the teaching of Lipkin. The modification would be obvious because one of ordinary skill in the art would be motivated to search for and discover information in a more flexible manner.

Per Claim 15:

The rejection of claim 14 is incorporated, and Lipkin further teaches wherein metadata comprises an Extensible Mark-up Language document (column 51, lines 52-58).

Response to Arguments

10. Applicant's arguments filed on 12/21/2004 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) However, to the extent that the teachings of Song may be even tangentially directed to the present invention as recited in independent claim 1, the following discussion details the specific aspects of present invention as recited in independent claim 1 that are not taught by Song:

(i) Song fails to teach a definition file as recited in independent claim 1. In particular, the Examiner has attempted to equate the procedure definition to the definition file. As

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described in Song, the procedure definition corresponds to the software development procedure (See Song, col. 1, 1. 47-48). In contrast, the definition file references all the files that are required to create the software development tool (See Instant Specification, paragraph (0023q). Thus, the procedure definition is clearly not equivalent to the definition file.

Examiner's response:

- a) Examiner strongly disagrees with applicant's assertion that Song fails to disclose the claimed limitations recited in claim 1. Song clearly shows each and every limitation in claim 1.

As previously pointed out in the last Office Action (Mailed on 10/04/2004, par. 4), Song teaches creating a definition file defining an action to be performed by the software development tool ("The system contains a procedure definition which defines the software development procedure." in column 1, lines 47-48).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the definition file *references all the files* that are required to create the software development tool") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, see the rejection above in paragraph 7 for rejection to claim 1.

In the remarks, the applicant argues that:

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b) (ii) Song fails to teach a schema as recited in independent claim 1. In particular, the Examiner has attempted to equate an interface that allows the user to select phase, activity, system components, etc. (See Song, col. 1, 11. 48-50) with the schema. As described in the specification, the schema describes the input that the software development tool collects to generate the entity (i.e., output of the software development tool) (See Instant Specification (0024)). Thus, an interface that allows the user to selected phase, etc. is clearly not equivalent to the schema.

Examiner's response:

b) Examiner strongly disagrees with applicant's assertion that Song fails to disclose the claimed limitations recited in claim 1. Song clearly shows each and every limitation in claim 1.

As previously pointed out in the last Office Action (Mailed on 10/04/2004, par. 4), Song teaches creating a schema defining characteristics of a plurality of desired inputs for the software development tool ("An interface allows users to select phase, activity, and system components and execute other utility programs or choose options." in column 1, lines 48-50; the interface allows the users to create a schema defining characteristics of a plurality of desired inputs for the software development tool).

In addition, see the rejection above in paragraph 7 for rejection to claim 1.

In the remarks, the applicant argues that:

c) (iii) Song fails to teach a resource file as recited in independent claim 1. In particular, the Examiner has attempted to equate the browser interpreter with the resource file. As described in

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Song, the browser interpreter interprets selections of the user (made via the interface) (See Song, col. 4, 1. 66 - col. 5, 1. 42). In contrast, the resource file defines how the data, input by the user, is to be processed to produce the desired output (See Instant Specification, paragraph (0030)).

Thus, the resource file defines how to interpret a given input (i.e., what to do when a given input is received) while the browser interpreter merely performs the function when a given input is received.

In view of the above, Song does not support the rejection with respect to independent claim 1. Independent claims 22 and 25-28 include at least the same limitations as independent claim 1. Thus, Song also does not support the rejection with respect to independent claims 22 and 25-28. In addition, Song does not support the rejection with respect to the dependent claims. Accordingly, withdrawal of this rejection is respectfully requested.

Examiner's response:

c) Examiner strongly disagrees with applicant's assertion that Song fails to disclose the claimed limitations recited in claims 1-7, 11 and 16-28. Song clearly shows each and every limitation in claims 1-7, 11 and 16-28.

As previously pointed out in the last Office Action (Mailed on 10/04/2004, par. 4), Song teaches creating a resource file comprising information required by the software development tool at runtime ("A browser interpreter interprets the selection and decides how to form and execute each command. ... A project file contains the information about system components, physical locations of the system documents, documentation tools associated with documents,

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options selected, hyper-links to the documents, etc” in column 1, lines 50-52 and lines 55-59; the project file is interpreted as the resource file).

In addition, see the rejection above in paragraph 7 for rejection to claims 1-7, 11 and 16-28.

In the remarks, the applicant argues that:

d) As described above, Song fails to teach or suggest the present invention as recited in independent claim 1, from which claims 8-10 and 12-15 depend. The Applicant respectfully asserts that Lipkin fails to teach what Song lacks. In particular, the portions of Lipkin cited by the Examiner (col. 49 - col. 52) appear to only teach using extensible markup language technology with no teachings directed to generating a software development tool using a definition file, a schema, and a resource file. In view of the above, Song and Lipkin, whether viewed separately or in combination, do not support the rejection with respect to independent claim 1. In addition, Song and Lipkin, whether viewed separately or in combination, do not support the rejection with respect to the dependent claims 8-10 and 12-15. Accordingly, withdrawal of this rejection is respectfully requested.

Examiner's response:

d) Examiner strongly disagrees with applicant's assertion that the combination of Song and Lipkin fails to disclose the claimed limitations recited in claims 8-10 and 12-15. The combination of Song and Lipkin clearly shows each and every limitation in claims 8-10 and 12-15.

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In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, see the rejection above in paragraph 9 for rejection to claims 8-10 and 12-15.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
May 24, 2005


WEI Y. ZHEN
PRIMARY EXAMINER